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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,330	07/23/2003	Takahiro Tanaka	2562/69798/JPW/FHB	7771

7590 03/13/2006

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EXAMINER	
COONEY, JOHN M	
ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/625,330	TANAKA, TAKAHIRO	
	Examiner	Art Unit	
	John m. Cooney	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 September 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0404*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's arguments filed 9-22-05 have been fully considered but they are not persuasive.

The following new rejection is set forth in light of applicants' amendment:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' now claimed range of variation of air-permeability throughout the entire body values was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for this range of values is not found in applicants' supporting disclosure. This is a new matter rejection.

The following rejections are maintained as set forth below:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claims are confusing as to intent because it can not be determined if the processes as claimed, defined by the language "...is enabled to be formed without...", are inclusive of methods of preparation including cell-opening operations.

Applicants' amendments and arguments have been considered, but rejection is maintained for the reasons set forth above. The language of new claim 20 has the same problems in the above regard as did now cancelled claim 1.

This limitation of applicants' claims constitutes as a process step what is not done rather than setting forth a positive process step as is required when claiming a process. Though applicants may exclude elements and process operations by limitation in the claims, such exclusion can not be the only process limitation defined by the claims.

This limitation is rendered further confusing when the terminology "healthy bubble" is looked at in light of the supporting disclosure. "Healthy bubble" in the context of this invention is understood to mean the step of opening cells by destroying the

membranes of the cells. That "healthy bubble", from the standpoint of claim interpretation, can be cell opening/membrane destruction through any means, it appears evident that by forming open-celled blocks, by definition, employs the very operation, "healthy bubble" that applicants are claiming to avoid. It can not be determined, in the instant case, what cell opening/membrane destroying operations constitute "healthy bubble" and which ones do not.

Additionally, the term "healthy bubble" from the standpoint of claim interpretation can not be afforded the definition of "healthy bubble" proffered by applicants' supporting disclosure at page 7 bridging 8.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Maruyama et al.(4,264,743).

Maruyama et al. disclose preparations of flexible open-celled polyurethanes having low-air permeability and being formed from feedstock including polyols, isocyanates, catalysts, foaming agents, oxyalkylene-siloxane foam stabilizers, and hydrocarbon fluid compounds which read on the processes and products claimed(see column 4 line 17 - column 8 line 36, column 5 line 50-59, column 9 lines 20-29, and

column 16 lines 64-65, as well as, the examples, and the entire document). Further, even though the disclosure of the reference is not seen to be limited to its illustrative examples of silicon foam surfactants, Maruyama et al. does disclose specific hydroxy functional polysiloxane-polyoxyalkylene copolymers (see for example column 7 lines 3-8; MW of chain = 1439, approx. 20/80 ratio of EO to PO) meeting the ranges of values of applicants' claims.

Maruyama et al.'s formed products appear to have consistency in permeability values throughout the samples they test. Since difference is not seen in the products realized, it is seen that the ranges of variation of air permeability values now recited in applicants' claims are inherent to the teaching of Maruyama et al. Additionally, without applicants' ranges of permeability values being based on specific sample thicknesses, they are seen to be of little distinguishing value in the patentable sense.

Applicants' arguments have been considered, but rejection is maintained for the reasons set forth above.

Maruyama et al. is maintained to disclose examples of open-cell polyurethane foams having air permeabilities as claimed (see again the examples). Further, difference between the processes of Maruyama et al. and the processes of the claims are not established in fact or seen based on the manufactured products resulting from the processes.

All other rejections over prior art are withdrawn in light of reconsideration, in that they are not seen to be more pertinent to the instant invention than the above

Murayama et al. reference. The same applies to the prior art cited in the PTO-1449 which accompanies this Office action. These references, however, are maintained as being art of relevant interest to the instant invention.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY, JR.
PRIMARY EXAMINER
Group 1700